

REMARKS

In the Office Action dated March 16, 2010, the Examiner: (1) objected to claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 due to minor informalities; (2) rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter; and (3) rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, first paragraph for lack of enablement. In view of the foregoing, Applicants respond as follows:

1. Response to Objection to Claims

The Examiner objected to claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 due to minor informalities. The Examiner requested that the instances of “said siRNA” and “candidate siRNA” be corrected to recite “said siRNA sequence” and “said candidate sequence.” Through the amendments above, Applicants have addressed these issues.

2. Response to Rejection under 35 U.S.C. § 112, ¶1

The Examiner rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, first paragraph. As an initial matter, the Examiner asserts that claim 86 recites “the sense region” but does not have an antecedent basis for it. Applicants have amended the claim to change the first instance of “a sense sequence” to “a sense region,” thereby providing antecedent basis.

The Examiner also made a more general indefiniteness rejection, asserting that the claims were invalid because they did not recite an identity to the target. Applicants respectfully submit that this is not a proper rejection for indefiniteness. However, in the interest of furthering prosecution, Applicants have added to each independent claim, the feature of the sense sequence being at least 90% complementary to a region of the target. Support for these amendments may, for example, be found in paragraph [0117] and [0260] of the specification.

3. Response to Rejection 35 U.S.C. § 112, ¶2

The Examiner rejected claims 43-54, 57-60, 68, 70-77, 79, 81 and 84-87 under 35 U.S.C. § 112, ¶2. The Examiner asserted that although the specification is enabling for methods for obtaining an siRNA molecule for a target gene wherein the method comprises identifying a set of candidate siRNA sequences comprising a sense sequence having similarity to the target gene or having an antisense sequence with complementarity to the target gene, and applying a computer algorithm to the candidate siRNA sequences, the specification does not reasonably provide enablement for methods of obtaining an siRNA molecule for a target gene, wherein the method comprises identifying a set of candidate siRNA sequences comprising any sense sequence.

Applicants respectfully disagree with the rejection, but in the interest of furthering prosecution, Applicants have amended each of the independent claims to recite that the sense sequences are at least 90% similar to a region of the target. Support for these amendments may be found in paragraphs [0117] and [260] of the specification. In view of these amendments, Applicants request that the rejection be withdrawn.

Applicants have also added new dependent claims 92-94, which recite that the candidate siRNA sequences are 100% similar to a region of the target.

Applicants have also added new dependent claims 95-96, which describe the possibility of overhang regions and the presence an antisense sequence. Support for these claims may, for example, be found in paragraph [0266] of the specification.

Applicants have also added new claims 97-99 which recite that the sense region is 19 bases in length. Support for these claims may, for example, be found in paragraph [0217] of the specification.

Finally, consistent with their duty of candor, Applicants draw the Examiner's attention to the allowed claims in co-owned application USSN 10/095,383 and co-pending applications 10/940,892 and 12/802,647.

Applicants: KHVOROVA *et al.*
Serial No.: 10/714,333
Filing Date: November 14, 2003
Amendment and Response to Non-Final Office Action
Page 13 of 13

Applicants submit that no additional fees, other than the fees for the petition for extension of time, the filing of the RCE and additional claims, are due with this filing. However, if any additional fee is deemed necessary, Applicants authorize the Patent Office to charge the Deposit Account No. 11-0171 for any such sum.

Respectfully submitted,

/Scott D. Locke/

Scott D. Locke
Registration No.: 44,877
Attorney for Applicants